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November 3, 2002

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Mark Bourgeois

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## **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In RE:

Serial no.: 09/939,491  
Filing date: 08/24/2001  
For: Clematis Plant named 'Avalanche'  
Inventor: White  
Atty. Docket no.: P41  
Group Art Unit: 1661  
Examiner: McCormick

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

## **RESPONSE**

Dear Sir:

This is in response to the Office Action dated 09/30/2002. No additional fees are believed to be necessary.

### **Rejection under 35 U.S.C. 102b:**

The claim was rejected under 35 USC 102b as being anticipated by Plant Breeders Right grant number 4711 in view of Avalanche being sold in the United Kingdom.

The combination of a non-enabling printed publication with foreign commercial use is not a bar to patentability under 35 U.S.C. 102(b) for plant patents. Every element of a new plant variety can not be disclosed in a printed publication. A non-enabling publication fails as a reference under 102(b). The cited printed publication does not contain every material element of the claimed invention.

Further, foreign public or commercial activity fails as a barring activity under 102(b). Combining these two "non-references" to make a rejection under 102(b) is not proper.

In order to properly reject the claim under 35 U.S.C. 102(b), every element of the claimed invention must be found in a single reference, as required under *LeGrice*. In the present case, the cited Plant Breeder's Rights certificate was taken in combination with the sale in the United Kingdom as being sufficient to bar patentability. Therefore, the reference was not a single reference and rejection is improper.

It is respectfully requested that the 102b rejection be withdrawn.

The claimed plant is now believed to be in condition for allowance.

Respectfully submitted,



Mark P. Bourgeois  
Reg. No. 37,782